UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner

Case IPR2020-00129
Patent RE 45,380

PETITIONERS' REPLY TO ADDRESS 35 U.S.C. § 314(a) AND 37 C.F.R. § 42.5

Petitioners submit this Reply to address the § 314 factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. March 20, 2020).

Judge Schiltz Issues "Ready for Trial" Dates, not Actual Trial Dates: The parties' "Ready for Trial" date was originally June 1, 2021, but has already been extended to August 1, 2021.[1] It is likely that this date will again be extended. Indeed, Judge Schiltz's final "Ready for Trial" date in patent proceedings is, on average, over eight months after the original "Ready for Trial" date. Ex-1289. For example, in the *QXMedical* litigation, Judge Schiltz issued an April 15, 2019 "Ready for Trial" date. Ex-1290 at 9. That date was later extended, per stipulation of the parties, to November 1, 2019. Ex-1291 at 10. A trial date was finally set for February 24, 2020, more than ten months after the original "Ready for Trial" date. Ex-1292 at 1. Judge Schiltz's scheduling orders do not provide trial dates, and whatever date is finally set in this litigation, it will be long after the Board's Final Written Decision.

"Other Factors" Indicate that a § 314 denial is Inappropriate: Other than by advancing an incorrect construction of "interventional cardiology devices," Teleflex does not dispute that the prior art discloses all claim limitations. Due to Petitioners' strong invalidity showing, the Board should not deny under § 314.

[1] The schedule was extended after Patent Owner filed an Amended Complaint adding two additional patents. Medtronic is preparing to file IPRs for these patents.

Judge Schiltz Grants Post-Institution Stays: Judge Schiltz has granted every post-institution request to stay litigation pending reexamination or IPR. *See* Ex-1293. Judge Schiltz is also expecting a merits-based institution decision in these IPRs. In the co-pending *QxMedical* litigation—that involves the same family of patents challenged here—Judge Schiltz granted a stay pending the institution decision in this IPR after QxMedical agreed to suspend its limited sales and waive its anticipation and obviousness defenses. Ex-1294. The Judge further stated that if the Board institutes, "the Court will invite the parties to brief whether the stay should extend through the conclusion of the review process." *Id.* The Judge will certainly entertain Petitioners' motion to stay in the event of institution.

The Litigation has not Significantly Progressed: An important consideration under this factor—whether Petitioner unreasonably delaying in seeking IPR—favors Medtronic. *See Apple*, IPR2020-00019, Paper 11 at 11. Indeed, Medtronic filed these IPRs roughly 4 months after the Complaint and before Patent Owner filed its infringement contentions. *See id.* (noting that "it is often reasonable for a petitioner to wait to file its petition until" after receiving infringement contentions).

Patent Owner Asserts only a Sub-Set of the Challenged Claims: In the District Court, Patent Owner asserts only a small fraction of the Challenged Claims. Ex-1295 at 2-3.

Dated: May 19, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on May 19, 2020, a copy of PETITIONERS' REPLY TO ADDRESS 35 U.S.C. § 314(a) AND 37 C.F.R. § 42.5 was served in its entirety by electronic mail on Patent Owner's counsel at the following addresses indicated in Patent Owner's Mandatory Notices:

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